

REMARKS

Applicants respectfully request reconsideration and allowance in view of the foregoing amendment and the following remarks. Applicants amend claims 22-23 and 30 without prejudice or disclaimer.

Rejection of Claims 22-25, 27-32 and 34-35 Under 35 U.S.C. §101

The Office Action rejects claims 22-25, 27-32 and 34-35 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Applicants amend claims 22, 23, and 30 to recite computer-implemented methods and selecting candidate image samples via a processor. These amendments tie portions of the computer-implemented claims to a particular apparatus, namely a processor. As such, these claims are directed to statutory subject matter. Applicants respectfully request that the 35 U.S.C. §101 rejection of claims 22-25, 27-32, and 34-35 be withdrawn.

Rejection of Claims 22-25, 27, 29-32 and 34 Under 35 U.S.C. §103(a)

The Office Action rejects claims 22-25, 27, 29-32 and 34 under 35 U.S.C. §103(a) as being unpatentable over Ezzat et al. ("Visual Speech Synthesis by Morphing Visemes") ("Ezzat et al.") in view of Jiang et al. ("Visual Speech Analysis with Application to Mandarin Speech Training") ("Jiang et al.") and further in view of Cox et al. ("Speech and language processing for the next-millennium communications services") ("Cox et al."). Applicants thank the Examiner for the clear and detailed explanation of the rejection and the three ways to show prior inventorship under the third option outlined in 37 C.F.R. §1.131(b). Applicants opt to show facts such, in character and weight, as to establish reduction to practice prior to the filing of the application. Applicants submit a second affidavit under 37 C.F.R. §1.131 supplemental to the

previously filed affidavit. As the Examiner pointed out on page 14 of the Office Action, diligence must be considered from the time period right before August 2000 (the publication date of Cox et al.) to Mar 29, 2001 (the filing date), or a period of roughly eight months.

Further, reasonable diligence is all that is required of the attorney. Reasonable diligence is established if attorney worked reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient. Work on a related case(s) that contributed substantially to the ultimate preparation of an application can be credited as diligence. MPEP 2138.06. In this case, Exhibit #1 of the Affidavit shows that Wendy Koba had a very steady stream of assigned cases between August 2000 and March 2001, generating reasonable backlog of cases. Exhibit #1 of the Affidavit shows that Wendy Koba had a total of 32 new domestic patent applications from August 2000 to March 2001, 15 from August 2000 to December 2000 and 17 from January 2001 to March 2001. On top of that, Wendy Koba had a total of 29 domestic amendments and 32 foreign amendments. In this time, Wendy Koba had a total of 93 cases to work on in roughly 8 months. The meticulously recorded dates for each case provide an indication that Wendy approached these cases in roughly chronological order and worked expeditiously to move each case forward.

On the matter of diligence in this particular application, Applicants provide statements in the affidavit showing the diligence of Wendy Koba in preparing the application. Applicants provide the entire timeline available to them at this time to establish diligence for the required period of just before August 2000 to 29 March 2001. On 5 April 2000, Wendy Koba received a letter from Ann E. Taylor of the AT&T Intellectual Property group with instructions to prepare and file the application 2000-0042 within 6 months, or roughly by October 5, 2000. Affidavit, paragraph 4. On 11 April 2000, Wendy Koba sent a letter to inventor Eric Cosatto

acknowledging that the patent submission had been assigned to her. Affidavit, paragraph 5. On 17 July 2000, Wendy Koba sent a letter to Eric Cosatto acknowledging a publication date of Eric Cosatto's paper on August 1, 2000. Affidavit, paragraph 6. On 24 August 2000, Eric Cosatto wrote Wendy Koba an email requesting the status of the application. Affidavit, paragraph 7. On 2 October 2000, Wendy Koba wrote an email to Eric Cosatto explaining that two "emergency" cases had taken priority over Eric Cosatto's application. Affidavit, paragraph 8. These "emergency" cases from AT&T are not identified, but presumably their preparation took precedence over 2000-0042 and delayed the usual preparation process. This is not an uncommon occurrence in typical patent prosecution practice, as certain applications must be drafted with extreme haste in order to avoid losing priority rights or beat a publication date or for various other reasons.

Next, on 8 November 2000, Eric Cosatto wrote Wendy Koba an email requesting a status update of the application. Affidavit, paragraph 9. Shortly thereafter, in mid-November 2000, Wendy Koba's son was diagnosed with Type I diabetes. She spent several weeks attending to this matter. Affidavit, paragraph 10. This event led to a delay in completing docket items. This delay can be shown by the completion dates of items in Exhibit #1 of the affidavit. For example, on pages 3 and 4 of Exhibit #1, items which were received between November 20 and December 7 were completed after a longer than usual interval, being completed in February instead of December. This caused a delay in the otherwise orderly, chronological workflow of cases.

In addition to these factors, in December 2000, AT&T "paced" filings in Dec. to hit a specific number, thereby causing another delaying factor in an otherwise steady docket. Affidavit, paragraph 11. This potential delay was not caused by Wendy Koba, but was rather due to an AT&T policy of "pacing" filings to arrive at a specific number of filings for the year. On 2 March 2001, Wendy Koba wrote an email to Eric Cosatto with the application draft.

Affidavit, paragraph 12. Later that same day on 2 March 2001, Eric Cosatto wrote back to Wendy Koba with a revised version of the application draft. Affidavit, paragraph 13. On 14 March 2001, Wendy Koba sent Eric Cosatto an email including the application, drawings, and signature papers for filing the patent application. Affidavit, paragraph 14. On 19 March 2001, Eric Cosatto wrote a letter to the other inventors with the final draft of the application. Affidavit, paragraph 15. On 26 March 2001, inventor Gerasimos Potamianos wrote an email to Eric Cosatto indicating that assignment papers were sent. See Affidavit, paragraph 16. On 29 March 2001, Wendy Koba wrote an email to Ann E. Taylor indicating that application was filed and the application was filed 29 March 2001 and assigned Appl. No. 09/820,396. Affidavit, paragraph 16 and 17.

Applicants submit that this record of the docket, coupled with the intervening events and correspondence between August 2000 and March 2001 provides sufficient supporting evidence in favor of a finding of reasonable attorney diligence on behalf of Wendy Koba and further in favor of a priority date prior to that of Cox et al. Therefore, Applicants submit that Cox et al. is not available as a prior art reference under 35 U.S.C. §102(a) or §103(a) and further submit that claims 22-25, 27, 29-32 and 34 are patentable and in condition for allowance. Applicants respectfully request that the rejection be withdrawn.

Rejection of Claims 28 and 35 Under 35 U.S.C. §103(a)

The Office Action rejects claims 28 and 35 under 35 U.S.C. §103(a) as being unpatentable over Ezzat in view of Jiang in further view of Cox and Brand (“Voice Puppetry”) (“Brand”). Applicants submit that for the same reasons as explained above, Cox et al. is not available as prior art. Therefore, Applicants request that the rejection of claims 28 and 35 be withdrawn.

CONCLUSION

Having addressed all rejections and objections, Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited. If necessary, the Commissioner for Patents is authorized to charge or credit the **Novak, Druce & Quigg, LLP, Account No. 14-1437** for any deficiency or overpayment.

Respectfully submitted,

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By: 

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